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UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 09/734,043  
Appellants : Matthew W. MENDERINK et al.  
Filed : December 12, 2000  
TC/A.U. : 2151  
Examiner : Hassan A. Phillips

Docket No. : 2766-101  
Customer No. : 06449  
Confirmation No. : 3510

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and Trademark Office  
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**APPELLANTS' REPLY BRIEF UNDER 37 C.F.R. § 41.41**

Sir:

The following comprises a reply to the Examiner's Answer ("Answer") mailed April 25, 2005.

**REPLY TO PRIOR ART REJECTIONS**

I. Claim Rejections - 35 U.S.C. § 102

A. Independent Claims 1 and 8

The Examiner asserts that the term "feature" recited in independent claims 1 and 8 could be interpreted broadly by a skilled artisan, and Appellants have failed to significantly narrow the scope/definition of the term. Thus, the Examiner has interpreted the term "features" as "models and predetermined templates/designs taught by Fleskes."<sup>1</sup> Appellants respectfully submit that the Examiner has erred in his interpretation.

Claim 1 recites, inter alia, "a web page-forming component for forming the personal web page incorporating one or more of the features of the web site in response to an input provided by the user via the Internet." Independent claim 8 has a

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<sup>1</sup> Answer at 11, ¶1.

similar feature. The "features" recited in claim 1 are "features of the web site." The preamble of claim 1 provides antecedent basis for this term, e.g., predetermined features that can be incorporated into the personal web page. Thus, the "one or more features" of claim 1 can be incorporated into a personal web page.

In contrast, the models and predetermined templates/designs taught by Fleskes cannot be incorporated into a personal web page. Rather, a user of Fleskes selects the template, and enters data about a new organization into the template. A new web page is designed to have a "similar look and feel" as an existing organization web page.<sup>2</sup> In other words, the models and templates/designs are not "features" (i.e., content) incorporated into a web page as in the claimed invention; they are simply used to format a web page.

Further, the Examiner asserts that the "web page-forming component" of claims 1 and 8 is "an application program 26," as "the application is a component of system (10), (Fig. 1), and the application creates web pages, (col. 6, lines 47-51)."<sup>3</sup> Appellants suggest, nevertheless, that Fleskes fails to disclose the "web page-forming component" as claimed.

Fleskes describes at column 6, lines 47-51 that:

After data is input to a database 22, the application program 26 in accordance with the present invention can generate images that can be displayed as web pages, visible to a user on a display device 14 with the use of a web browser 28 or other web page viewing program.

Further, "[t]he application program 26 is the application program that implements the present invention."<sup>4</sup>

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<sup>2</sup> Fleskes, col. 8, line 39-col. 9, line 1. See., e.g., Fleskes, col. 2, line 66-col. 3, line 7; col. 24, lines 48-64; col. 25, lines 20-34; and col. 25, line 45-col. 26, line 11.

<sup>3</sup> Answer at 11, ¶2.

<sup>4</sup> Fleskes, col. 5, lines 49-50.

The application program 26 of Fleskes, however, does not "form[ ] the personal web page incorporating one or more of the features of the web site [e.g., predetermined features that can be incorporated into the personal web page] in response to an input provided by the user via the Internet." That is, Fleskes' generation of images that can be displayed as web pages is not analogous to forming a personal web page by incorporating predetermined features of a web site in response to an input provided by a user as in the claimed invention. Thus, Fleskes does not disclose, teach or suggest the "web page-forming component" of claims 1 and 8.

B. Dependent Claims 3 and 10

The Examiner contends that although Appellants have "single[d] out an example in the teachings of Fleskes where a user clicks on a view button to view an image of a web page. ... Fleskes also teaches: 'if the master page 60 is editable, then Create 7[6], Modify 78, and Delete 80 buttons are also available', (col. 10, lines 13-16.)"<sup>5</sup> This contention is without merit.

Claim 3 recites " a single action construction component, wherein the user may add one or more of the web site features to the personal web page with a single action." Claim 10 has a similar feature. As discussed above, Fleskes does not add one or more features of a web site to a personal web page. Thus, Fleskes cannot add the features by a single action. Further, the view 74, modify 78 and delete 80 buttons, as illustrated in Figure 5A of Fleskes, are editing buttons, and they do not add features of a web site to a personal web page as does the "single action construction component" of the claimed invention. They are simply used to view, modify and delete information contained in a list.<sup>6</sup> The create 76 button creates and renders a new item in the detail

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<sup>5</sup> Answer at 13, ¶1.

<sup>6</sup> See, e.g., Fleskes, col. 9, lines 48-59.

page 72. The new item is not a feature that can be incorporated into a personal web page, and the detail page 72 is not a personal web page.

In addition, the Examiner avers that "there is no indication in the claims that indicates a users [sic] state," and "there is no indication ... that clearly indicate[s] whether or not there are steps performed before a user adds one or more web site features ... with a single action."<sup>7</sup> Claim 3 is not a method claim. Claim 3 recites "a single action construction component, wherein the user may add one or more of the web site features to the personal web page with a single action." The "single-action construction component" of claim 3 clearly sets forth the number of actions (e.g., single) required for adding the one or more web site features. It is immaterial that the user may perform steps, unrelated to adding one or more web site features to the personal web page, before adding the features in a single action – i.e., by using the single action construction component. Thus, Fleskes does not teach or disclose the "single action construction component" of claim 3 or the step of "adding one of the web site features to the personal web page with a single action" of claim 10.

C. Dependent Claims 4 and 11

The Examiner asserts that the optional components of Fleskes are related to the models and predetermined templates/designs.<sup>8</sup> This assertion is unsupported.

Claim 4 recites "an annotation component that allows the user to create and store a comment related to one of the features in the personal web page, such that the comment may be later accessed." Dependent claim 11 recites "creating an annotation related to one of the features in the personal web page; storing said annotation; and accessing said annotation during subsequent use of the personal web page." There is absolutely no support, teaching or suggestion in the Fleskes reference that the optional

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<sup>7</sup> Id.

<sup>8</sup> Answer at 14, ¶1.

components, e.g., list of comments, is related to one of the templates (which the Examiner incorrectly associates with "features" of the present invention) used to create a web page. Furthermore, Fleskes does not expressly or inherently disclose how the list of comments is created or stored. In other words, a user in the system of Fleskes does not create and store an accessible comment related to one of the features in the personal web page using an annotation component. Clearly, Fleskes does not meet the claimed features of claims 4 and 11.

II. Claim Rejections - 35 U.S.C. § 103

A. Dependent Claims 2 and 9

Claim 2 recites "wherein the input further provides biographical information on the user to be included in the public component." Claim 9 recites "providing biographical information to be included in the public component." The Examiner acknowledges that Fleskes fails to disclose, teach or suggest this feature.<sup>9</sup> The Examiner, however, asserts that it was well known at the time the invention was made to provide biographical information on a user in a web page that may be viewed by the public. Further, the Examiner contends that Hickman discloses this feature in paragraph 68 of page 6.<sup>10</sup> For example, the Examiner avers that Hickman "shows biological information on a user in a web page that could be viewed by the public for the purpose of explaining to the public the biography of an individual associated with a business."<sup>11</sup> In addition, the Examiner states that "[d]oing this allows a user instant access to a requested web page, (page 6, paragraph 68),"<sup>12</sup> and "[t]hus, it [would have

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<sup>9</sup> Answer at 15, ¶¶3.

<sup>10</sup> Answer at 16, ¶¶1.

<sup>11</sup> Id.

<sup>12</sup> Id.

been] obvious to modify the teachings of Fleskes with Hickman to produce the claimed invention."<sup>13</sup>

The Examiner, however, has not provided any reasoning why a skilled artisan would be motivated to combine the Fleskes and Hickman references, nor does the Examiner provide any reasoning why a skilled artisan would be motivated to modify Fleskes in accordance with Hickman. A description of the purported teachings of Hickman – where those purported teachings do not provide a motivation to combine or modify the references – is not sufficient for combining the Fleskes and Hickman references, or modifying Fleskes. Notwithstanding, Hickman discloses a biography of an individual for individual users. However, there is no disclosure that the biography is included in a "public component." Fleskes also fails to disclose, teach or suggest a "public component," and the predetermined templates of Fleskes do not include an entry for a biography. Indeed, it would not have been obvious to combine the systems of Fleskes and Hickman but for the teachings of the present invention. Accordingly, the combination of Fleskes and Hickman is improper as being impermissibly motivated in hindsight by the teachings of the present application.

B. Dependent Claim 5

Claim 5 recites "wherein the server allows a third party to access the public component from the web site in a single action." The Examiner acknowledges that Fleskes fails to disclose, teach or suggest this feature.<sup>14</sup> The Examiner asserts that "[a]llowing a third party to access a public component from a web site in a single action was also well known in the art at the time the invention was made." However, the Examiner does not provide any reasoning why one skilled in the art would have been motivated to combine the Fleskes and Hickman references, or modify Fleskes in

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<sup>13</sup> Answer at 17, bridging paragraph.

<sup>14</sup> Answer at 7, §2.

accordance with Hickman. Thus, the Examiner's purported rationale is merely a broad conclusory statement with no evidence supporting the statement. A broad conclusory statement regarding the teachings of a reference(s), standing alone, is not evidence.<sup>15</sup> Moreover, combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability, the essence of hindsight.<sup>16</sup> Clearly, the Fleskes and Hickman references do not suggest the claimed invention, and there is no sufficient basis for combining the references but for the teachings of the present invention. Thus, the proposed modification is no more than a hindsight reliance on the teachings in the present application of the advantages of the present invention.

C. Dependent Claims 13-16

Claims 13 and 15 recite "the features that appear in the public component link back to the web site," and claims 14 and 16 recite "the features that appear in the private component link back to the web site." The Examiner now takes "Official Notice" of these features.<sup>17</sup> Although it is permissible for the Examiner to take official notice of facts not in the record, such is rare when an application is under final rejection or action under 37 C.F.R. § 1.113.<sup>18</sup> Notwithstanding, the Examiner cites three new references, Newman, MacPhail and Te.<sup>19</sup> However, none of the references, either alone or in combination with each other and/or Fleskes, discloses one or more features that can be

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<sup>15</sup> See McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d (BNA) 1129, 1131 (Fed. Cir. 1993); In re Sichert, 566 F.2d 1154, 1164, 196 USPQ (BNA) 209, 217 (CCPA 1977).

<sup>16</sup> See, e.g., Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453 (Fed. Cir. 1998).

<sup>17</sup> Answer at 8, ¶4.

<sup>18</sup> MPEP § 2144.03, at 2100-136.

<sup>19</sup> Answer at 17, ¶1.

incorporated into a personal web page. Correspondingly, they do not disclose features that link back to a web site.

Further, the Examiner has not provided any reasoning why one skilled in the art would have been motivated to modify Fleskes to incorporate the teachings of Newman, MacPhail, and/or Te. The Examiner simply states that "[a]lthough Fleskes discloses hyper-linking to other web sites in the passage, the same functionality could be used to link back to an original web site that incorporates the hyperlink."<sup>20</sup> The Examiner's purported rationale is merely a broad conclusory statement, which is flawed for the following reasons.

Fleskes describes entering arbitrary web addresses and hyper-linking to other web sites.<sup>21</sup> These actions are not the same as linking back to an original web site that contained the features, and a skilled artisan would not have modified Fleskes to link back to an original web site because Fleskes does not form a personal web page by incorporating features from a web site. Accordingly, the proposed modification of Fleskes is improperly motivated by hindsight reliance on Appellants' disclosure.

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<sup>20</sup> Answer at 17, §1.

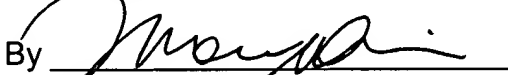
<sup>21</sup> Fleskes, col. 11, lines 15-22.



Appellants' Reply Brief  
under 37 C.F.R. § 41.41  
Serial Appln. No. 09/734,043

All of the grounds for the rejections of the present claims as advanced by the Examiner are submitted to be unsupportable by the record, and thus improper. The Honorable Board is therefore respectfully requested to reverse the final rejection, and to direct the passage of this application to issue.

Respectfully submitted,

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Date: June 21, 2005

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